

REMARKS

Reconsideration and withdrawal of the rejections of the claims in view of the amendments and remarks presented herein is respectfully requested. Claims 1-22 and 27-34 are canceled without prejudice or disclaimer, and solely to advance prosecution of the present application. Claims 23 and 25 have been amended, and claims 35-36 are newly added. Claims 23-26 and 35-36 are now pending in this application.

Interview Summary

Applicants' agent thanks Examiner Devi for the courtesy of a personal interview on March 31, 2004. The interview included a discussion of proposed claim amendments.

Double Patenting

Claims 22, 23, 25, 29, and 32 have been rejected under the judicially created provisional obviousness type double patent over claims 22, 23, 32 and 33 of application USSN 08/565,943. Applicant submits herewith a provisional terminal disclaimer thereby overcoming this rejection.

The present application was filed in the name of five inventors: Michael A. Apicella, Melvin G. Sunshine, Na-Gyong Lee, Bradford W. Gibson and Rasappa Arumugham. Rasappa Arumugham, however, has been deleted as an inventor in the present patent application because his invention is no longer being claimed in the application. The prosecution of the application has resulted in the cancellation of certain claims, so that fewer than all of the currently named inventors are the actual inventors of the invention currently being claimed in the application. Because Rasappa Arumugham is not an inventor on the presently claimed invention, Wyeth Holding Corporation is not an assignee of the presently claimed invention. Thus, the University of Iowa Research Foundation and The Regents of the University of California are the assignees of the entire right, title, and interest in the present application. The University of Iowa Research Foundation and The Regents of the University of California have jointly executed the enclosed terminal disclaimer.

Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 22-26, 29, 32 and 33 have been rejected under 35 U.S.C. § 112, second paragraph for various reasons. Claims 23 and 25 have been amended, and claims 1-22 and 27-34 have been cancelled. Applicants assert that these rejections are rendered moot in view of the amendments to the claims. Therefore, Applicants respectfully request that this rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

Rejections under 35 U.S.C. § 112, First Paragraph (New Matter)

Claims 22-26 and 32 have been rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors at the time the application was filed had possession of the claimed invention. This is a new matter rejection.

In particular, the examiner objected to amendments to claims 22 and 29. These claims have been cancelled. Applicants assert that this rejection is rendered moot in view of the cancellation of claims 22 and 29, and the amendments to the pending claims. Therefore, Applicants respectfully request that this rejection under 35 U.S.C. § 112, first paragraph (new matter) be withdrawn.

Rejections under 35 U.S.C. § 112, First Paragraph (Enablement)

Claims 22-26, 29, 32 and 33 have been rejected under 35 U.S.C. § 112, first paragraph as not being enabled by the specification. Applicants have amended the claims. Therefore, Applicants respectfully request that this rejection under 35 U.S.C. § 112, first paragraph (enablement) be withdrawn.

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Conclusion

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (612) 337-2540 to facilitate prosecution of this application.

Enclosed is a check for the Petition for Extension of Time, Terminal Disclaimer, and correction of inventorship. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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